

REMARKS

Applicant respectfully requests reconsideration. Claims 76-78, 81, 86-88, 91, 106, 108, 110, 112 and 115-123 were previously pending in this application.

Claims 76, 78, 81, 86, 88, 91, 108, 110, and 120 are amended herein. Claims 106, 121-123 are hereby cancelled. New claims 124-177 are added. As a result, claims 76-78, 81, 86-88, 91, 108, 110, 112, 115-120 and 124-153 are still pending for examination with claims 76, 78, 81, 86, 88, 91, 110, 112, 130, 134, 138, 142, 146 and 150 being independent claims. No new matter has been added.

Support for the amended claims can be found throughout the instant specification. Support for the claim amendments can be found at least, for example, at page 2, line 21 through page 3, line 20, in particular, at page 3, lines 1-2, 9-11 and 17-19, of the specification as originally filed. In brief, amended claims 76-108 are directed to siRNA that is "perfectly complementary" and incorporate the limitations of now canceled claim 106. The new claims 130-177 are directed to "21 mer" or "23 mer" siRNA and incorporate limitations of now cancelled claims 121 or 123.

Applicants thank the Examiner for the indication that the claim objections and rejections under 35 USC 112 are withdrawn.

Rejection Under 35 U.S.C. 102

Claims 76-78, 81, 86-88, 91, 108 and 117 have been rejected under 35 U.S.C. 102(b) as being anticipated by Manche et al. (1992) Molecular and Cellular Biology 12:5238-5248, as evidenced by Stratagene pBluescript II Phagemid Vectors Instruction Manual for Catalog #212207, downloaded from the Stratagene, Inc. website on January 11, 2007 and a Basic Local Alignment Search Tool (BLAST) analysis, available through NCBI, of nucleic acid sequence "cccgtaccagctttgttccc" completed on January 11, 2007.

Applicants respectfully traverse the rejection for at least all the reasons presented in the previous response to office action, but in the interest of advancing prosecution Applicants have amended the rejected claims by adding the limitation requiring the isolated dsRNA to be perfectly

complimentary to an mRNA. The amended claims are not anticipated by Manche et al. Applicants respectfully request withdrawal of the rejection.

Claims 76-78, 81, 86-88, 91, 108, 110, 112, 116, 118, 119, 120, and 122 have been rejected under 35 U.S.C. 102(b) as being anticipated by Bevilacqua et al. (1996) Biochemistry 35:9983-9994, as evidenced by the NCBI BLAST, as available online on 10/12/2007 at <http://www.ncbi.nlm.nih.gov/blast>.

Applicants respectfully traverse the rejection, but in the interest of advancing prosecution Applicants have amended the rejected claims by adding the limitation requiring the isolated dsRNA to be perfectly complimentary to an mRNA. The new claims include a limitation of a length of 21 or 23 nucleotides. The amended and new claims are not anticipated by Bevilacqua et al. Therefore the Applicants respectfully request withdrawal of the rejection.

Claims 110, 112, 116, 118, 119, 120, and 122 have been rejected under 35 U.S.C. 102(b) as being anticipated by Roshak et al. (1996) J. Biol. Chem. 271:31496-31501 (herein after "Roshak"), as evidenced by the NCBI BLAST, as available online on 10/12/2007 at <http://www.ncbi.nlm.nih.gov/blast>.

Applicants respectfully traverse the rejection, but in the interest of advancing prosecution Applicants have amended the rejected claims by adding the limitation requiring the isolated dsRNA to be perfectly complimentary to an mRNA. The new claims include a limitation of a length of 21 or 23 nucleotides. The amended and new claims are not anticipated by Roshak et al. Therefore the Applicants respectfully request withdrawal of the rejection.

Double Patenting Rejection

Claims 76-78, 81, 86-88, 91, 106, 108, 110, 112 and 115-123 have been *provisionally* rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17, 20-23, 76 and 80 of copending Application No. 10/255,568, as presented on 10/5/2007. It is requested that the rejection be held in abeyance until allowable subject matter in

the cited application is identified. At that time, Applicants will consider filing a terminal disclaimer.

Claims 76-78, 81, 86-88, 91, 106, 108, 110, 112 and 115-123 have been *provisionally* rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-55 of US Patent Application No. 11/142,866 over claims 48, 49, 51, 53-57, 60-64, 67-73 and 75-125 of US Patent Application No. 10/433,050.

Applicants note that these applications are later filed applications. Accordingly, it is requested that this provisional rejection be withdrawn and maintained in the later filed cases if appropriate. However, Applicants respectfully disagree that the double patenting rejection is appropriate.

Applicants wish to make it clear on the record that the instant application and the cited patent applications do not have common ownership, as common ownership is defined in MPEP 706.02(l). MPEP 706.02(l) states that the "term 'common ownership' means wholly owned by the same person(s) or organization(s) at the time the invention was made." The instant patent application is owned by four entities, Whitehead Institute for Biomedical Research, Massachusetts Institute of Technology, Max-Planck-Gesellschaft zur Förderung der Wissenschaften E.V and University of Massachusetts Medical Center. US Patent Application Nos. 11/142,866 and 10/433,050 are owned by Max-Planck-Gesellschaft zur Förderung der Wissenschaften E.V solely.

MPEP 804 II B(1) teaches that "obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 USC 103(c)(2) and (3), when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent." Although the patent application and two cited patent applications have a common inventor and one owner in common, the applications are not commonly owned (common ownership requires all of the same owners). At the time of the instant invention the claimed invention was not assigned to or under an obligation of assignment solely to the Max-Planck-Gesellschaft zur Förderung der

Wissenschaften E.V, but rather was under an obligation of assignment to Whitehead Institute for Biomedical Research, Massachusetts Institute of Technology, Max-Planck-Gesellschaft zur Förderung der Wissenschaften E.V and University of Massachusetts Medical Center. At the time of the instant invention the claimed invention was not subject to a research agreement between each of the owners of the instant application and the single owner of the two patent applications. The instant application is not commonly owned or the subject of a joint research agreement with the owner of US Patent Application Nos. 11/142,866 and 10/433,050. Because of the lack of common ownership a terminal disclaimer is unavailable to overcome this rejection. Further the joint owners of the instant patent application have no control over the prosecution of US Patent Application Nos. 11/142,866 and 10/433,050 which include only one owner in common. Thus it is not possible for Applicants to control which patent is issued first by the patent office.

Application of double patenting in a circumstance when the patents are not commonly owned and do not have identical inventorship and the claims under rejection have the earliest effective priority date would be contrary to the public policy reason for double patenting. The public policy behind the double patenting doctrine is to allow the public to freely use a patent upon its expiration. "The basic concept of double patenting is that the same invention cannot be patented more than once, which, if it happened, would result in a second patent which would expire some time after the original patent and extend the protection time wise." *General Foods Corp. v. Studiengesellschaft Kohle MbH*, (972 F.2d 1272, 1279, 23 USPQ2d 1839, 1844 (Fed. Cir.. 1992)). (See also *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993) and MPEP 804B). The instant application would not be expected to expire prior to the expiration of the patent applications if they are to issue. Issuance of the instant patent application would not extend the patent protection beyond a point by which the public would otherwise be free to use the technology. Thus, double patenting is not appropriate in the instant circumstance.

Further, the judicially created doctrine of double patenting was developed to create a basis for a rejection in situations where patents are not citable against one another and thus where an examiner was unable to enforce the rule of one patent per invention. (*General Foods*, 972 F.2d at 1278-81). In the instant situation, the pending application is available as a reference for rejection under 35 USC 102(e) against both patent applications because it was the first filed.

Application No. 09/821,832
Amendment dated January 31, 2008
Reply to Office Action of October 31, 2007

16

Docket No.: W0571.70010US02

Accordingly, Applicants request withdrawal of the rejection in view of US Patent
Application Nos. 11/142,866 and 10/433,050.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: March 7, 2008

Respectfully submitted,

By 

Helen C. Lockhart

Registration No.: 39,248

WOLF, GREENFIELD & SACKS, P.C.

Federal Reserve Plaza

600 Atlantic Avenue

Boston, Massachusetts 02210-2206

(617) 646-8000